

**REMARKS**

The last Office Action has been carefully considered.

It is noted that claims 1-7 are rejected under 35 U.S.C. 103(a) over the U.K. patent '145.

Also, the drawings are objected to.

In connection with the Examiner's objection to the drawings, the Examiner's attention is respectfully directed to the features of claim 7.

It is specifically defined there that the saw blade back 270 as measured at cone and/or taper edges 279 is wider than the groove bottom 292 of the circumferential groove 290 of the guide roller 29. It is believed that the grounds for the objection to the drawings are therefore eliminated.

After carefully considering the Examiner's grounds for the objection of the claims over the art, applicants have canceled claims 3-7 and introduced almost all their features into claim 1, the broadest claim on file.

It is respectfully submitted that the new features of the present invention which are now defined in the amended claim 1 are not disclosed

in the references and can not be derived from them as a matter of obviousness.

In addition to the features of the original claim 1, the amended claim 1 defines that the guide roller is formed as a stroke-support roller. It also defines the dimension of the saw blade back relative to the groove bottom, and the dimension of the guide roller and the groove.

It is respectfully submitted that the new features of the present invention are used in their interaction and interjunction, they provide for highly advantageous results, and they can not be considered as obvious.

When the power compass saw is designed in accordance with the present invention, its blades are configured with little outlay such that they have identical, minimized play on the sides, independently of the thickness of the saw blade, the saw blades are no longer guided solely at the saw blade back but primarily at the side surfaces, and the tendency for the saw blade to saw incorrectly is greatly minimized.

The reciprocating stroke-support guide roller acts together with the saw blade to bring about an improved sawing advancement with a reduced cutting channel width, because of more swift guidance of the saw blade which does not undergo torsional movement. Since the saw blade

back is wider at taper or cone edges than the groove bottom of the circumferential groove, the saw blade back is prevented from resting directly on the groove bottom with a lateral support of the saw blade. The taper of the groove sides with the guide roller of 5° and the taper of the saw blades of 7° on the back provide secure lateral guidance. And finally, forming the groove bottom not wider than the saw blade back and particular with 1.5 mm provides a controlled, reliable but precise manner of operation of the compass saw.

These features of the present invention provide for the highly advantageous results when they are used in their interaction and interjunction.

Applicants have to respectfully disagree with the position of the Examiner that these features constitute an obvious matter of design choice. While of course any apparatus invention has a special design, the new features of the present invention do not constitute just a design choice, but instead are suggested to provide a highly efficient and advantageous operation of the power compass saw.

These features are not disclosed in the prior art applied by the Examiner, they can not be derived from it as a matter of obviousness, and they also do not constitute the matter of simple design choice. The present

invention was developed in Robert Bosch GmbH, a company which is a leader in many important advances in power tools, including power compass saws. The present invention is one of such advances which can not be considered as obvious.

In connection with this, the Examiner's attention is respectfully directed to some decisions which can be considered as relevant to the present invention. In the decision *ATD Corp. v. Lydall, Inc.*, 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998) it was stated:

"Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine in the way they were combined by the inventor. "

No suggestions for the new features of the present invention, which are provided in the inventive power compass saw and used in their interaction and interjunction, are provided in the prior art or can be proposed as a matter of design choice by a person skilled in the art.

The inventors have been working on the present invention for a significant time, analyzing and testing other power tools, and finally designed a power compass saw which is highly advantageous and new. In

connection with this, it is believed also to be advisable to cite the decision *Fromson v. Anitec Printing Plates, Inc.*, as reported in 45 USPQ 2d 1269, 1276 (Fed. Cir. 1997):

"That an inventor is probed the strength and weakness of the prior art and discovered an improvement that escapes those who came before is indicative of unobviousness, not obviousness. The district court did not correctly apply the law obviousness, for there is no suggestion or teaching in the prior art to select from the various known procedures and combine specific steps, along with a new electrical structure in the way that is described and claimed by Fromson. The judgment of invalidity is reversed."

It is believed that this decision is also clearly applicable to the issue of unobviousness of the present application over the prior art.

Claim 1 as amended should be considered as patentably distinguishing over the art and should be allowed.

Claim 8 additionally defines that the saw blade back 270 has a straight portion and a beveled portion, with diametrically opposed edges at a transition therebetween, and a width between the diametrically opposed edges 279 is greater than a width of a bottom 292 of the circumferential groove 290 of the guide roller 29. This claim defines the embodiment of Figure 7. As a result of the above mentioned features, a lateral shift and/or torsional movement of the saw blade 27 during sawing is prevented, and a particularly correct course of cutting during sawing is ensured.

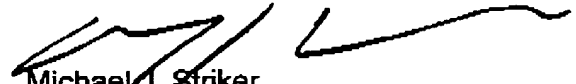
This feature is not disclosed in the reference applied by the Examiner. As can be seen from Figure 3, while the saw blade back is tapered, there is no straight portion and tapered portion with diametrically opposite edges at a transition between them, with the width between diametrically opposite edges greater than a width of the bottom of the groove of the roller. Thus, this reference does not teach these new features of the present invention as defined now in claim 8.

Therefore claim 8 should also be considered as patentably distinguishing over the art and should also be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Striker", written over the printed name.

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